

## REMARKS

### **Priority Claim**

Applicant requests that the Office acknowledge the claim of priority under to 35 U.S.C. 371. The present application claims priority to International Application No. PCT/EP2003/005300, filed 05/21/2003, which claims the benefit of German Application Nos. 102 23 254.7, filed 05/24/2002; 102 54 822.6, filed 11/25/2002; and 103 10 396.1, filed 03/07/2003.

The applicant thanks the Office for its acknowledgement of the priority claim to PCT/EP2003/005300. The Office indicated that without a translation of the earlier applications earlier priority could not be recognized. A certified translation of German Application No. 102 23 254.7, filed 05/24/2002 is provided herewith.

### **Claim Rejections – 35 USC § 103**

The Office has quoted the statute from 35 USC 103(a), which is referenced herein. The Office has rejected claim 32-39 as being unpatentable over US Publication No. 2004/0229908 A1 of Nelson in view of other references. Applicant has carefully considered the Office rejections and respectfully submits that the claims, as supported by the arguments herein, are distinguishable from the cited reference.

According to the MPEP §2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art."

A useful presentation for the proper standard for determining obviousness under 35 USC §103(a) can be illustrated as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

The Office rejected Claims 32-38 under 35 USC 103(a) as being unpatentable over the '908 reference in view of US Patent No. 6,143,325 issued to Dennis et al. The Applicant has carefully reviewed the cited references and respectfully disagrees.

The applicant respectfully submits that the Office has misconstrued the disclosure of the '908. Before, however, addressing the substantive issues raised by the Examiner, the applicant must address the appropriateness of the '908 reference as a reference. The claimed invention was filed properly claiming priority to, *inter alia*, German Application No. 102 23 254.7, filed 05/24/2002. The cited '908 reference was filed July 9, 2003, after the PCT filing date of the present application. The '908 reference claims priority to 6 priority documents.

The '908 reference is a continuation-in-part of US Application No. 10/192,414 filed July 9, 2002 (published as 2002/01982231), which is a continuation-in-part of US Application No. 09/615,639 filed July 13, 2000, now issued as US Pat. No. 6,417,177. It claimed priority to Provisional Application Nos. 60/143,767 filed July 13, 1999 (application for review not available in PAIR), 60/175,051, filed January 7, 2000, 60/202,140 filed May 5, 2000, and 60/479,748 filed June 19, 2003.

As the '908 reference is a continuation-in-part, the proper priority date, and therefore the effective date of the reference, must be determined by a review of the content of the priority document. The '639 application and the resulting '177 reference fail to disclose the use of nefazodone in the disclosed method for treating Parkinson's disease or at all. The '767 application was unavailable for review, but expired on the filing date of the '639 reference. If it disclosed the use of nefazodone, it would have been unavailable as a priority document for either

the '908 reference or the '414 reference for purposes of teaching the use of nefazodone. The '151 and '140 contained no teachings which can be construed to indicate the use of nefazodone in accord with the present invention. Furthermore, these applications, even if they did contain such teachings would be improperly claimed as priority documents as they had expired by the filing of the '414 application and such teachings were not present in the '639 application. Thus the earliest document in the priority chain for which priority can be claimed for the alleged teachings of the cited '908 reference is the '414 application filed July 9, 2002, after the claimed invention's priority date of 05/24/2002 from German Application No. 102 23 254.7.

The attached translation of the applicant's earliest priority document, DE102 23 254.7 supports the applicant's contention that the invention was the subject of a patent claim in a Paris Convention member country and that that document was properly the basis for a claim of priority under the PCT. DE102 23 254.7 was filed May 24, 2002, more than a month before the cited reference's earliest effective date for purposes of any mention of nefazodone. The applicant therefore submits that the cited reference is therefore inapplicable as a prior art reference, as its effective date is after the foreign priority date of the present invention.

The Office specifically relies upon the '908 reference as the basis of its 103 rejections of claim 32-38 and 39. The Office does not allege that either the '325 reference, the FDA Glossary of terms, nor the van Walraven reference disclose the claimed invention, namely:

Claim 32: A method for the treatment of Parkinson's disease comprising:  
administering to a patient in need thereof a composition for the  
treatment of Parkinson's disease, said composition comprising 2-[3-  
[4[-(3-chlorophenyl)-1-piperazinyl] propyl]-5-ethyl-4-(2-  
phenoxyethyl)-2H-1,2,4,-triazol-3(4H)-one or a pharmaceutically  
acceptable salt thereof.

Instead, these references are used by the office to fill in admitted gaps in the disclosure of the '908 reference. In light of this, the applicant respectfully submits that the rejection of claims 32-

39 as unpatentable in light of the '908 reference in combination with the '325 reference, the FDA Glossary of terms, and or the van Walraven reference is inappropriate, The applicant respectfully requests that the Office withdraw this rejection and issue a timely notice of allowance.

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

Respectfully submitted,

**/Andrew P. Cernota, Reg. No. 52,711/**

Cus. No. 24222  
Vern Maine & Associates  
PO Box 3445  
Nashua, NH 03061-3445  
Tel. No. (603) 886-6100, Fax. No. (603) 886-4796  
patents@vernmaine.com

Vernon C. Maine, Reg. No. 37,389  
Andrew P. Cernota, Reg. No. 52,711  
David A. Rardin, Reg. No. 52,153  
Attorneys/Agents for Applicant